

**AMENDMENT UNDER 37 C.F.R. § 1.111**  
**U.S. Appl'n No. 10/631,865**

**Attorney Docket No. Q76751**

**AMENDMENTS TO THE DRAWINGS**

Figures 6(a-c), 7(a-b), 8(a-b) and 9 have been labeled as "RELATED ART."

Replacement Sheets For these Figure are included

Attachment:

Replacement Sheets.

**REMARKS**

Claims 1-11 have been examined. The Examiner has indicated that claims 5-11 contain allowable subject matter. By this Amendment, claim 1 is cancelled. Accordingly, claims 2-11 are all the claims pending in this application

Claims 2-4 stand rejected. Claim 2 has been rejected under 35 U.S.C. § 103(a) as being unpatentable in view of U.S. Patent No. 6,172,849 to Schick ("the '849 patent"). Claims 3-4 are rejected as being unpatentable over the '849 patent in view of the U.S. Patent No. 6,178,067 to Schick. In addition, the Examiner has objected to claim 6. For at least the following reasons, Applicant respectfully traverses these rejections.

**AMENDMENTS TO THE DRAWINGS**

Figures 6(a-c), 7(a-b), 8(a-b) and 9 have been labeled as "RELATED ART." Replacement Sheets For these Figure are included with this Amendment. Applicant respectfully submits that these drawing amendments overcome the Examiner's objections.

**AMENDMENTS TO THE CLAIMS**

Claim 2 has been rewritten in independent form as shown above. Claim 7 has been amended to correct an obvious typographical error. Claim 1 is cancelled.

**CLAIM OBJECTIONS**

The Examiner has objected to claim 7 as allegedly failing to limit claim 5. In view of the amendment to claim 7, Applicant submits that this objection is overcome.

### **CLAIM REJECTIONS**

To establish a *prima facie* case of obviousness, three basic criteria must be met:

- first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings,
- second, there must be a reasonable expectation of success, and
- finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

(MPEP 2143).

Whether a prior art reference that “teaches away” from the claimed invention is a significant factor to be considered in determining obviousness. (MPEP 2145). It is improper to combine references where the references teach away from their combination. (MPEP 2145).

The ‘849 patent discloses a disk cartridge wherein biasing springs are removed because of the inherent drawbacks of such springs when used to close a access opening shutter. (Abstract; col. 1, 57-62). When a cartridge 10 is ejected from a drive, a finger 48a which is engaged in a cut-out 16d rotates shutter 16 toward the closed position. When the shutter has rotated to the closed position, detent member 24 engages a cut-out 16c to hold shutter 16 in the closed position. (col. 5, lines 16-22). Thus, the shutter is retained in the closed position by the engagement of detent 36 with cut-out 16c. (See Fig. 6). This arrangement is advantageous, according to the teachings of the ‘849 patent, because it eliminates the need to have a spring to close the shutter, resulting in additional space inside the cartridge, and complicated components necessary to implement a spring biasing system. (col. 4, lines 56-63). Accordingly, one of ordinary skill in the art would not modify the cartridge disclosed in the ‘849 patent to add a

spring to close the shutter -- this is directly contrary to the clear and express teachings of the '849 patent and is, indeed, the very thing the '849 patent teaches should be avoided.

While, admittedly, springs used to shut shutters on disk drives were known in the art at the time of the Applicant's invention, a statement by the Examiner that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art" at the time the claimed invention was made because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. (MPEP 2143.01).

Accordingly, Applicant respectfully submits that claim 2 is patentable over the cited art. As claims 3-4 depend from claim 2, Applicant respectfully submits that these claims are patentable over the cited art at least based on this dependency.

**CONCLUSION**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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